TD AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Appellant:	David R. MacLean	)	
		)	
Serial No:	09/550,049	)	
		)	
Filed:	April 14, 2000	)	
		)	
For:	SAFETY DEVICE FOR USE WITH A VIAL	)	Appeal No.
		)	
		)	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to the new points raised by the examiner in the Examiner's Answer dated July 26, 2007.

1. Rejection of claims 22-27 under 35 U.S.C. 102(e) as being anticipated by Mumford (US 6,575,941)

In the response to the Arguments raised in the Appeal Brief filed on March 15, 2007, the examiner now apparently posits, as far as can be understood, that so long as an element is shown in the prior art that conceivably could be argued to be an equivalent of the claimed element, it really doesn't matter what the limitations of the phrase(s) surrounding the claimed element are, and furthermore that as long as the reference element shown in the prior art is capable of performing a function/operation, then an anticipation rejection could be made. Indeed, quoting the examiner:

"Arguendo, even if viewed that they are positively claimed Mumford does disclose (1) vial (114, 10 or 112 for examples) and hub (110) and the latch and collar element are capable of the function/operation of the claims. [Specically] Mumford device would have a vial, (discussed above) a collar that slides over the vial (part which goes over the [vail] hub (fig. 1A), 'a latch member extending from the neck member in direction toward the center of the collar' (figure 4 and 8 [how] the Mumford device attaches to the vial and hub, and (4) 'when the collar placed about the vial is moved toward a hub [or one end of the hub] of the vial, the latch member would latch onto another end of the hub when the collar is adjacent to one end of the hub (see figure 4, 1A, or 1B).

Under this analysis all the **claimed** element are disclosed in Mumford and those elements are fully capable of satisfying all structural, functions, spatial, and operational limitations in the claim, as currently written." At page 6 of Examiner's Answer. (Bolded word is in the Examiner's Answer. Underlines added for emphasis.)

Appellant respectfully submits that the rationale given by the examiner for supporting his anticipation rejection, in addition to not being supported by the facts when the prior art is viewed objectively and compared with the claimed subject matter, is moreover not supported by the law.

In *Richardson v. Suzuki Motor Co. Ltd*, 868 F.2d 1226 (Fed Cir. 1989), the court held that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. (cite omitted) The identical invention must be shown in as in complete details is contained in the patent claim." At 1236.

From the examiner's comments, for example the quoted comments from the Examiner's Answer, it is apparent that even the examiner recognizes that not all limitations

in the claims are met by Mumford. This is particularly clear insofar as the examiner argues that Mumford "would have" a vial ... and the element disclosed in Mumford are "fully capable of satisfying all structural, functions, spatial and operational limitations in the claims, as currently written." But, as discussed in the Appeal Brief, the Mumford syringe does not come close to the safety device set forth in the pending claims. At the very least, Mumford fails to disclose, explicitly or inherently, the claimed feature that when the collar is placed about a vial and moved toward a hub of the vial until adjacent one end of the hub, the latch member is latched onto another end of the hub.

The examiner appears to be arguing that the elements disclosed in Mumford are equivalents of the elements set forth in the claims. Yet this is more akin to an obviousness rejection and is set forth clearly by the *Richardson* court as follows: "The jury has erroneously been instructed that anticipation may be shown by equivalents, a legal theory that is pertinent to obviousness under Section 103, not to anticipation under Section 102. (cite omitted) The jury requested a definition of 'equivalent' during its deliberations and was given the Webster's dictionary definition 'corresponding or virtually identical, especially in effect or function.' This narrow definition which does not accord with that of [the *Graver Tank* decision], may have minimized the legal error in instructions." At 1236-1237.

Be that as it may, even under an obviousness analysis, Mumford does not have equivalents that perform substantially the same function to achieve substantially the same result as required in the at issue claims.

Moreover, Appellant respectfully submits that the examiner has erred in his presupposition that the components of the Mumford device would be capable of satisfying all of the structure, functional, spatial and operational limitations required by the at issue claims. Such presupposition is without merit in an anticipation rejection. This is made clear by the Board of Appeals in *Ex parte Standish*, 10 U.S.P.Q.2d 1454 (1989) where the Board held that "... anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product." At 1457.

Thus, it is respectfully submitted that the examiner's position with regard to his anticipation rejection of the at issue claims under Mumford, and also under Olliffe to be discussed hereinbelow, is based on a large measure to conjecture and presuppositions, based on having the instant invention before him. In other words, the anticipation rejection of the at issue claims under Mumford, and also Olliffe, is a good example of a rejection based on prohibited hindsight. Such rejection could not stand.

2. 35 U.S.C. 102(b) rejection of claims 22 and 25 under Olliffe (US 5,135,509)

The same arguments above in rebuttal to the examiner's comments are equally applicable herein. For this rejection, the examiner once more demonstrates that he is merely focusing at the element per se without paying any attention to the limitations or modifying phrases that give life to those elements. This is apparent in light of the following comments by the examiner at page 8 of the Office Action:

> "[Specically] Olliffe device would also have a collar that slides over the syringe barrel and hub (25) 'a latch member extending from a neck member in a direction towards the center of the collar' (figure 8c and the latching piece that holds the housing open and attaches the device under the ridge of Olliffe hub 25) and 'when the collar placed about the syringe and hub is moved toward a hub of the vial'. It is [examiners] position that the claims *do not* require the collar to be placed [bout] the vial/syringe/hub, in a specific direction (proximal/distal) or order, simply that the collar be placed on the [vail]/syringe barrel and the latch member is one another end of the hub.
>
> Under this analysis all of the **claimed** elements are disclosed in Olliffe and those element are fully capable of satisfying all structure, functional, spatial, and operational limitations in the claims, as currently written." (Italicized and bolded words by the examiner.)

Olliffe, as discussed in the Appeal Brief, does not disclose any latch member that extends from the neck in a direction towards the center of the collar or that the collar is placed about a vial and moved toward the hub of the vial, or of any latch member that latches onto any portion of the hub when the collar is moved. Indeed, by his quoted comments, the examiner again demonstrates that he has not taken into consideration how the various limitations, as recited, are arranged in claims 22 and 25 in his rejection. It moreover confirms that the examiner's rejection is based on conjecture not supported by the cited references. The anticipation rejection of claims 22 and 25 therefore is believed to be without merit.

In view of the above, Appellant respectfully submits that the examiner's rejections are without merit and not sustainable, and therefore should be reversed by the Board.

Respectfully submitted,

Louis Woo, Reg. No. 31,730
Law Offices of Louis Woo
717 North Fayette Street
Alexandria, VA 22314
Phone: (703) 299-4090

Date: Sept 19, 2007